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09/466,965	12/20/1999	YOSHIHIRO TSUKAMURA	SON-1710	1790

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EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/18/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/466,965

Applicant(s)

TSUKAMURA ET AL.

Examiner

Tongoc Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-2,4-5,9-11,17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9-11 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 3/31/2004 has been entered.

Claims 1 and 9 are amended. Claims 17-19 are added. Claims 1-19 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 3/31/2004 have been fully considered but they are not persuasive.

Applicant contends that Pare does not teach accessing the generated private key, decrypting a symmetric key, and decrypting the encrypted text using the decrypted symmetric key when the user's next instruction is one that specifies a decryption of an encrypted text. Examiner respectfully disagrees. Pare discloses an DES encryption library (symmetric key system) and public key encryption library (e.g. col. 14, lines 38-51) that generate private key, encrypting and decrypting text according to user's instruction (e.g. col. 18, lines 5-34 and col. 21, lines 50-col. 22, lines 35).

In response to Applicant's remark that Pare does not teach the limitation of newly added claim 17. Pare discloses the biometric apparatus including a fingerprint scanner (fingerprint detection means and fingerprint identification

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means (col. 18, lines 5-18) for verifying fingerprint data (col. 8, lines 20-27, fingerprint quality software) and means for encryption and decryption as stated above.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 4-5, 9-11, 17-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Pare Jr. et al. (U.S. Patent No. 5,838,812).

In respect to claims 1, 9 and 13, Pare teaches a system and method for identify an unknown user with a unique biometrics sample previously stored and can be networked between other computer systems carrying out all necessary executions (see abstract).

“the host computer comprising:

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input means for inputting a user's instruction;

command output means for generating from the user's instruction an instruction command which request a predetermined processing to be executed and for outputting it; and communication means for communicating with an external unit" (see col. 11, lines 28-35, col. 18, lines 5-27); and

a fingerprint identification apparatus comprising:

communication means for communicating with said host computer (see col. 12, lines 20-23);

processing control means for executing a predetermined processing according to the instruction command input from said host computer by said communication means (see col. 11, lines 47-50);

fingerprint detection means for detecting a fingerprint and for generating fingerprint data (see col. 11, lines 50-52);

storage-information recording means for recording the fingerprint data and storage information related to the fingerprint data (see col. 11, lines 54-56); and

fingerprint identification means for verifying fingerprint data detected by said fingerprint detection means with the fingerprint data recorded by said storage information recording means (see Fig. 24 and 25, col. 18, lines 30-34).

Wherein said storage-information recording means stores a private key generated by the public-key encryption method (see col. 14, lines 32-64), and

Wherein said processing control means accesses the generated private key, decrypts a symmetric key, and decrypts the encrypted text using the decrypted symmetric key when the user's instruction specifies a decryption of an

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encrypted text wherein said processing control means generates a symmetric key and a public key to encrypt the symmetric key when the user's instruction specifies an encryption of plain text, and wherein the user's instruction is sent to the host computer through communication cable (see col. 14, lines 39-44, col. 18, lines 5-35 and col. 21, line 50-col. 22, line 35).

In respect to claims 2 and 10, Pare discloses all the limitations as applied to claims 1 and 9 above. Pare further discloses:

"said storage-information recording means allows recorded storage information to be accessed only once immediately after the fingerprint-identification result is affirmative (see Fig. 24).

In respect to claims 4 and 11, Pare discloses all the limitations as applied in claims 1, 9 and 13 above, Pare further discloses:

"said storage-information recording means stores a private key generated by the public-key encryption method (see col. 22, lines 27-35);

"said fingerprint identification apparatus further comprises encryption processing means for generating an encryption key, for performing encryption by the use of the encryption key, and for performing decryption" (col. 21, lines 35-45).

In respect to claim 5, Pare discloses all the limitations as applied to claim 4 and 13 above. Pare further discloses:

"said encryption processing means generates a public key and a private key according to the public key encryption method, and decrypts an encrypted

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text by the use of the private key” (see col. 21, lines 35-40 and col. 22, lines 30-35).

In respect to claim 17, Pare discloses a fingerprint identification apparatus in an authentication system used when stored information is manipulated, comprising:

Communication means for communicating with a host computer (see col. 12, lines 16-23);

Processing control means for executing a predetermined processing according to an instruction command input from the host computer by said communication means (see col 18, lines 5-7 and col. 17, lines 23-27);

Fingerprint detection means for detecting a fingerprint and for generating fingerprint data (see col. 18, lines 5-18);

Storage-information recording means for recording the fingerprint data and storage information related to the fingerprint data (see col. 18, lines 28-34); and

Fingerprint identification means for verifying fingerprint data detected by said fingerprint detection means with the fingerprint data recorded by said storage-information recording means (see col. 8, lines 8-11, col. 8, lines 20-27 and col. 18, lines 28-34);

In respect to claim 18, Pare discloses a fingerprint identification apparatus according to claim 17, wherein said storage-information recording means allows recorded storage information to be accessed only once immediately after the fingerprint-identification result is affirmative (see col. 15, lines 21-33).

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In respect to claim 19, Pare discloses a fingerprint identification apparatus according to claim 17, wherein said fingerprint identification apparatus further comprises encryption processing means for generating an encryption key, for performing encryption by the use of the encryption key, and for performing decryption (see col. 18, lines 8-11, 28-30).

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789.



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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran  
Art Unit: 2134

TT  
May 15, 2004

*Matthew D. Smithers*  
MATHEW SMITHERS  
PRIMARY EXAMINER  
*Art Unit 2137*